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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/254,870	08/16/99	SPENGLER	D 147-183PCT
HM12/1030			EXAMINER
COOPER & DUNHAM 1185 AVENUE OF THE AMERICAS NEW YORK NY 10036			ART UNIT PAPER NUMBER 1652 18
DATE MAILED:			10/30/00

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 8/16/99
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 1-49 is/are pending in the application.
- ☐ Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-48 are subject to restriction or election requirement.

#### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

Restriction to one of the following inventions is required under 35 U.S.C. § 121: .....

I. Claims 1-17 and 19-24, drawn to a nucleic acid, a method for identification and cloning of a nucleic acid, vector comprising the nucleic acid, host cell comprising the vector and a method of producing a polypeptide using the host cell, classified in Class 435, subclasses 69.1, 320.1, 325 and 455 and Class 536, subclass 23.5.

✓ II. Claims 18, 36, 39 and 41, drawn to a hybridizing nucleic acid, a method of detecting expression of a tumor suppressor or for diagnosing a predisposition to a tumor or a disorder by using the hybridizing nucleic acid and the use of the nucleic acid to treat a disease classified in Class 435, subclass 6 and Class 536, subclass 23.5.

III. Claim 25, drawn to a polypeptide, classified in Class 530, subclass 350.

IV. Claims 26 and 37-38, drawn to an antibody and a method for detecting expression using the antibody, classified in Class 435, subclass 7.1 and Class 530, subclass 387.9.

V. Claims 27-35, 40, and 42-46, drawn to a pharmaceutical composition comprising a nucleic acid molecule, a complementary nucleic acid molecule or a vector, a polypeptide, an antibody; a diagnostic composition and methods and uses for treating a disease using the composition, classified in Class 424, subclass 139.1, Class 514, subclasses 12 and 44.

VI. Claims 47-48, drawn to a process for identifying antagonists, inhibitors, agonists or activators to a tumor suppressor

comprising use of the polypeptide of claim 25, classified in Class 435, subclass 29.

Group V contains claims directed to the following patentably distinct species of the claimed invention: a nucleic acid molecule, a complementary nucleic acid molecule or a vector, a polypeptide, an antibody. If this group is elected, applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently none of the claims is generic.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

The inventions are distinct, each from the other because of the following reasons:

Groups I-IV are different and distinct chemical compounds that are patentably distinct. Group V is drawn to all of the compounds of groups I-IV as pharmaceutical and diagnostic compositions, and the use of them to treat diseases.

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Inventions III and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as to suppress tumors.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, as shown by their different classification, restriction for examination purposes as indicated is proper.

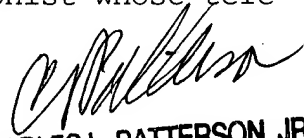
Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles L. Patterson, Jr., Ph.D. whose telephone number is (703) 308-1834. The examiner can normally be reached on any day of the week from 7:30 AM until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy, can be reached on (703) 308-3804. The fax phone number for this Group is (703) 305-7401.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Patterson  
October 27, 2000

  
CHARLES L. PATTERSON, JR.  
PRIMARY EXAMINER  
GROUP 1800